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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/718,995 | 11/21/2003 | Stephen Horniak | P-23,016-C | 9084 |

23307 7590 01/29/2007
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| EXAMINER |
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KIM, ANDREW

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| ART UNIT | PAPER NUMBER |
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3714

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/29/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/718,995 | Applicant(s) HORNIAK ET AL. | |
| | Examiner Andrew Kim | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2, 10, 18, and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Signals are non-statutory matter. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Gottschalk v. Benson*, 409 U.S. 63, 71 - 72, 175 USPQ 673, 676 (1972). Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al. (US 6,015,344).

Claims 1, 9, 17, 20, and 25. Kelly discloses an invention of providing an incentive for continued use of a slot machine, the method comprising the steps of:

providing a ticket dispenser integrally coupled with the slot machine (Abstract, fig. 2, item 22);

monitoring output signals of the slot machine (Abstract, fig. 13, item 614);

determining the occurrence of predetermined reward dispensing events based on the results of said monitoring step (Abstract, fig. 13, items 616 and 618); and

dispensing tickets by the ticket dispenser upon the occurrence of the predetermined reward dispensing events (Abstract, fig. 13, items 616 and 618).

Claims 2, 10, 18, and 26. Kelly discloses an invention wherein, in the monitoring step, the output signals include at least one of the following:

Coin-In signals indicating a number of coins inserted into the slot machine (col. 53:25, fig. 13);

Coin-Bet signals indicating a number of coins bet in the slot machine (col. 53:25, fig. 13);

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Coin-Won signals indicating a number of coins won from using the slot machine (col. 54:47-67, fig. 13); and

Card-In signals indicating a presence of a player tracking card in the slot machine (col. 7:55).

Claims 3, 4, and 13. Kelly discloses an invention wherein, in the providing step, the ticket dispenser is programmable by an operator such that the predetermined reward dispensing events can be modified (col. 4:23-55).

Claims 5, 8, 11, 16, 19, 24, 27, and 30. Kelly discloses an invention wherein, in the determining step, the predetermined reward dispensing events include at least one of the following:

a first event wherein the total number of coins inserted or bet in the slot machine reaches a predetermined count value (col. 53:19 – col. 56:26, fig. 13);

a second event wherein the total number of coins inserted or bet in the slot machine reaches a predetermined maximum count value, or the total number of coins inserted or bet in the slot machine is equal to or greater than a predetermined minimum count value but less than the predetermined maximum count value and a random number currently generated by the ticket dispenser equals a predetermined comparison value (col. 12:22-39);

a third event wherein the total number of coins won from using the slot machine reaches a predetermined count value (col. 53:19 – col. 56:26, fig. 13); and

a fourth event wherein the total number of coins won from using the slot machine reaches a predetermined maximum count value, or the total number of coins won is equal to or greater than a predetermined minimum count value but less than the predetermined maximum count value and a random number currently generate by the ticket dispenser equals a predetermined comparison value (col. 12:22-39).

Claims 6, 14, 22, and 28. Kelly discloses an invention wherein the dispensing step includes:

detecting whether a player tracking card is present in the slot machine based on the output signals of the slot machine (Abstract, Column 3, line 29-Column 5, line 45, Column 7, line 40-Column 8, line 2, and Figures 1 and 9);

multiplying a predetermined number of tickets to be dispensed by a first number if the player tracking card is present (fig. 9 along with the related description);

multiplying the predetermined number of tickets to be dispensed by a second number if the player tracking card is not present (fig. 9 along with the related description); and

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dispensing the tickets according to the results of said multiplying steps (fig. 9 along with the related description).

Claims 7, 15, 23, and 29. Kelly discloses an invention further comprising:

displaying the first four digits of a total ticket count in response to a first selection of a designated switch in the ticket dispenser, the total ticket count being a count of the number of tickets dispensed by the ticket dispenser (col. 22:62-col. 23:62); and
displaying the second four digits of the total ticket count in response to a second selection of the designated switch after the first selection (col. 22:62-col. 23:62).

Claims 12 and 21. Kelly discloses an invention wherein the interface includes:

a display unit (fig. 1-15, col. 6:55 – col. 17:58);

a display interface unit for controlling the display unit (fig. 1-15, col. 6:55 – col. 17:58);

a central processing unit (CPU), including memory, for controlling the display interface unit and the ticket dispensing unit based on the output signals of the slot machine (fig. 1-15, col. 6:55 – col. 17:58);

a plurality of switches for communicating operator inputs to the CPU (fig. 1-15, col. 6:55 – col. 17:58); and

a relay for providing power to the ticket dispensing unit under control of the CPU (fig. 1-15, col. 6:55 – col. 17:58).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Kim whose telephone number is 571-272-1691. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read "Scott E. Jones". The signature is fluid and cursive, with the first name "Scott" and last name "Jones" being clearly legible, and "E." as a middle initial.

AK 1/22/2007

SCOTT JONES
PRIMARY EXAMINER